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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,171	04/09/2001	George M. Brookner	13668-960002	9225
23838	7590	09/10/2007		
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			EXAMINER ROBINSON BOYCE, AKIBA K	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 09/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/829,171

Applicant(s)

BROOKNER ET AL.

Examiner

Akiba K. Robinson-Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5, 9, 10, 12-16, 19, 20 and 24-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 9, 10, 12-16, 19, 20, and 24-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/10/07 has been entered.

Status of Claims

2. Due to communications filed 8/10/07, the following is a non-final office action. Claims 1, 3, 5, 9, 10, 12, 13, 14, 16, 19 and 20 have been amended. Claims 2, 2, 4, 6-8, 11, 17, 18, and 21-23 has been cancelled. Claims 24-35 have been added. Claims 1, 3, 5, 9, 10, 12-16, 19, 20, and 24-35 are pending in this application, and have been examined on the merits. The previous rejection has been withdrawn, and the following reflects the claims as amended. Claims 1, 3, 5, 9, 10, 12-16, 19, 20, and 24-35 have been rejected as follows.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 5, 9, 10, 12-16, 20, 25-27, 30 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al, (US 6,047,270), as previously cited by the examiner on 7/6/05.

As Per Claim 1, Joao et al discloses:

upon power-up of the device, immediately transmitting from the device to a remote device the system present location of the device, wherein the present location information of the device is transmitted automatically by the device without any user interaction, (Col. 12, lines 14-21, shows automatic/self activation of the apparatus, w/Col. 66, shows apparatus is programmed to automatically transmit transaction data, w/Col. 7, lines 1-7 and Col. 20, lines 23-29, shows data that is transmitted to communication device includes location of the transaction).

determining, at the remote device, a present location of the device based on the present location information, (Col. 20, lines 37-44, location information is displayed to the user on the device);

comparing at the remote device the present location of the device with previously stored location information of the device, (col. 8, lines 26-39, device is programmable to receive/analyze transaction data and limit the dollar amount of the transaction pertaining to the geographical location of the transaction, w/Col. 6, lines 40-42, test is performed to determine if the maximum number of unauthorized transactions have occurred [where an authorized transaction would be a transaction for an unauthorized location], in this case it would be obvious to compare the present location of the device with a previously stored location since when performing a test for an

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unauthorized location, one must have a base location to determine if another location is out of bounds or unauthorized);

determining, at the remote device, whether the present location of the device is within a predetermined region specified by the previously stored location information; and when the present location of the device is within the predetermined region, transmitting to the device from the remote device an authorization to use the funds; when the present location of the device is not within the predetermined region, transmitting to the device from the remote device a signal inhibiting use of the funds, (Col. 6, lines 42-50 and lines 53-60, shows transmission of signal to point-of-sale device indicating that the transaction is not approved or authorized/is approved and operator may then cancel the transaction/transaction can be processed, w/col. 20, lines 48-67, user then approves/authorizes or disapproves/voids the transaction);

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to compare the present location of the device with a previously stored location with the motivation of having data that will determine if a location is authorized or not authorized for a transaction.

As per claim 2, Joao et al discloses:

wherein said authorization is transmitted only if the present location matches the previously stored location, (Col. 6, lines 40-42, test is performed to determine if the maximum number of unauthorized transactions have occurred [where an authorized transaction would be a transaction for an unauthorized location], in this case it would be obvious to compare the present location of the device with a previously stored location

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and determine if there is a match since when performing a test for a transaction in an unauthorized location, if the current location does not match up with an authorized location, the transaction can not occur.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to compare the present location of the device with a previously stored location and determine if there is a match, with the motivation of having data that will determine if a location is authorized or not authorized for a transaction.

As per claim 4, Joao et al discloses:

communicating from the system to the device, data associated with the present location, (Col. 7, lines 1-7 and Col. 20, lines 23-29, shows data that is transmitted to communication device includes location of the transaction).

As per claims 5, 15, Joao et al discloses:

further comprising transmitting from the remote device to the device at least one of a zip code, a city name and a state name corresponding to the present location of the device, (Col. 7, lines 1-7 and Col. 20, lines 23-29, shows data that is transmitted to communication device includes city, town, village, state, country).

As per claim 6, Joao et al discloses:

powering up said device, the method being conducted when said device is powered up, (Col. 12, lines 14-21, shows automatic/self activation of the apparatus, w/Col. 66, shows apparatus is programmed to automatically transmit transaction data).

As per claim 7, Joao et al discloses:

transmitting is done when said device establishes a contact with said system, (Col. 20, lines 37-40, line 48-Col. 21, line 9, shows data transmitted to device by central processing computer is displayed on device and waits for reply from user, if response is received from user, this means that user then authorizes or declines the transaction, and there is no need for central processing computer to further transmit, but if central processing computer does not receive a reply from user, it then communicates with POS, but does not further communicate with device).

As per claim 8, Joao et al discloses:

contact with said system is terminated after the location of said device is determined, (Col. 21, lines 33-38, if unauthorized transaction count is incremented by central processing computer, transaction is cancelled or voided, in this case, location is determined since it is determined that transaction is unauthorized [due to an unauthorized location]).

As per claim 9, Joao et al discloses:

wherein transmitting from the device comprises transmitting the present location information over a telephone line, (Col. 5, lines 6-9, communication network and/or a telephone network or line).

As per claim 10, Joao et al discloses:

wherein transmitting from the device comprises transmitting the present location information over an internet connection, (Col. 4, lines 55-58, Internet).

As per claim 11, Joao et al discloses:

contact is made using the Internet, the location of said device is determined by using Internet service provider location identification, (Col. 4, lines 55-58, Internet).

As per claim 12, Joao et al discloses:

wherein transmitting from the device comprises transmitting the present location information over a cellular telephone system , (Col. 1, line 24, cellular communication device).

As per claim 13, Joao et al discloses:

wherein transmitting from the device comprises transmitting the present location information based on an output of a position determining apparatus of the device, (Col. 8, lines 35-43, geographical location/limitations).

As per claims 14, 30, 35, Joao et al doesn't explicitly disclose: wherein the position determining apparatus is a global positioning system receiver/wherein the location generator is a global position system receiver, but does disclose geographical location/limitations in Col. 8, lines 35-43, which suggests that an actual GPS system is not used but a locator system is capable of functioning in the same manner as the GPS.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include a device that is associated with a GPS system in conjunction with a locator system within the system taught by Eddy's with motivation if locating a device using Global Positioning System to operate the system more efficiently.

As per claim 16, Joao et al discloses:

a memory for storing a value indicative of the funds, (Abstract, lines 5-6, memory);

a location generator for generating present location information of the device, (Col. 7, lines 1-7 and Col. 20, lines 23-29, shows data that is transmitted to communication device includes location of the transaction, in this case, the central processing computer serves as the location generator since this computer is the one doing the transmitting);

a communication port for providing communication between the device and a remote device, (Col. 5, lines 6-9, communication network and/or a telephone network or line); wherein

the communication port transmits the present location information to the remote device automatically upon power-up of the device and without any user interaction, (Col. 12, lines 14-21, shows automatic/self activation of the apparatus, w/Col. 66, shows apparatus is programmed to automatically transmit transaction data, w/Col. 7, lines 1-7 and Col. 20, lines 23-29, shows data that is transmitted to communication device includes location of the transaction);

the communication port receives an authorization from the remote device to use the funds when a present location of the device as determined from the present location information indicates the present location of the device is within a preauthorized region of operation, and the communication port receives a signal from the remote device inhibiting use of the funds when the present location of the device indicates the present location of the device is outside the preauthorized region of operation, (col. 8, lines 26-39, device is programmable to receive/analyze transaction data and limit the dollar amount of the transaction pertaining to the geographical location of the transaction,

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w/Col. 6, lines 40-42, test is performed to determine if the maximum number of unauthorized transactions have occurred [where an authorized transaction would be a transaction for an unauthorized location], in this case it would be obvious to authorize a transaction based on whether or not the present location of the device is an unauthorized location, since the determination of whether another location is unauthorized if it is out of bounds, w/Col. 6, lines 42-50 and lines 53-60, shows transmission of signal to point-of-sale device indicating that the transaction is not approved or authorized/is approved and operator may then cancel the transaction/transaction can be processed, w/col. 20, lines 48-67, user then approves/authorizes or disapproves/voids the transaction);

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to authorize a transaction based on whether or not the present location of the device is an unauthorized location with the motivation of having data that will determine if a location is authorized or not authorized for a transaction.

As per claims 17, 18, Joao et al discloses:

apparatus for receiving from said system an authorization to access said funds, if said location is within a predetermined region/apparatus provides access to said funds if said location corresponds to a predetermined location, (col. 8, lines 26-39, device is programmable to receive/analyze transaction data and limit the dollar amount of the transaction pertaining to the geographical location of the transaction, w/Col. 6, lines 40-42, test is performed to determine if the maximum number of unauthorized transactions have occurred [where an authorized transaction would be a transaction for an

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unauthorized location], in this case it would be obvious to authorize a transaction based on whether or not the present location of the device is an unauthorized location, since the determination of whether another location is unauthorized if it is out of bounds, w/Col. 6, lines 42-50 and lines 53-60, shows transmission of signal to point-of-sale device indicating that the transaction is not approved or authorized/is approved and operator may then cancel the transaction/transaction can be processed, w/col. 20, lines 48-67, user then approves/authorizes or disapproves/voids the transaction);

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to authorize a transaction based on whether or not the present location of the device is an unauthorized location with the motivation of having data that will determine if a location is authorized or not authorized for a transaction.

As per claim 20, Joao et al discloses:

a local device for securely storing the funds, comprising: a memory for storing value indicative of the funds, apparatus associated with said device for determining a location of said device, (Abstract, lines 5-6, memory);

a location generator for generating present location information of the local device, (Col. 7, lines 1-7 and Col. 20, lines 23-29, shows data that is transmitted to communication device includes location of the transaction, in this case, the central processing computer serves as the location generator since this computer is the one doing the transmitting);

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a communication port for providing communication between the local device and a remote device system, (Col. 5, lines 6-9, communication network and/or a telephone network or line);

wherein the communication port transmits the present location information to the remote device automatically upon power-up of the device and without any user interaction, (Col. 12, lines 14-21, shows automatic/self activation of the apparatus, w/Col. 66, shows apparatus is programmed to automatically transmit transaction data, w/Col. 7, lines 1-7 and Col. 20, lines 23-29, shows data that is transmitted to communication device includes location of the transaction);

the remote device, comprising:

a database storing a preauthorized region of operation for the local device, (Col. 17, line 64-Col. 18, line 5, database)

wherein:

the remote device compares a present location of the local device provided by the present location information to the preauthorized region of operation, (col. 8, lines 26-39, device is programmable to receive/analyze transaction data and limit the dollar amount of the transaction pertaining to the geographical location of the transaction, w/Col. 6, lines 40-42, test is performed to determine if the maximum number of unauthorized transactions have occurred [where an authorized transaction would be a transaction for an unauthorized location], in this case it would be obvious to compare the present location of the device with a previously stored location since when

performing a test for an unauthorized location, one must have a base location to determine if another location is out of bounds or unauthorized);

the remote device issues an authorization to the local device to use the funds if the present location of the local device is within the preauthorized region of operation, the remote device issues a signal to the local device inhibiting use of the funds if the present location of the local device is outside the preauthorized region of operation (Col. 6, lines 42-50 and lines 53-60, shows transmission of signal to point-of-sale device indicating that the transaction is not approved or authorized/is approved and operator may then cancel the transaction/transaction can be processed, w/col. 20, lines 48-67, user then approves/authorizes or disapproves/voids the transaction);

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to compare the present location of the device with a previously stored location with the motivation of having data that will determine if a location is authorized or not authorized for a transaction.

As per claim 21, Joao et al discloses:

provides said authorization only if said present location matches said previously stored location, (Col. 6, lines 40-42, test is performed to determine if the maximum number of unauthorized transactions have occurred [where an authorized transaction would be a transaction for an unauthorized location], in this case it would be obvious to compare the present location of the device with a previously stored location and determine if there is a match since when performing a test for a transaction in an

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unauthorized location, if the current location does not match up with an authorized location, the transaction can not occur.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to compare the present location of the device with a previously stored location and determine if there is a match, with the motivation of having data that will determine if a location is authorized or not authorized for a transaction.

As per claim 25, Joao et al discloses:

further comprising determining the present location of the device based on caller identification information, (col. 7, lines 7-11, transmitted data includes the telephone number).

As per claim 26, Joao et al does not specifically disclose the following:

further comprising determining the present location of the device based on a network address of the device, but does disclose that the Internet is used for data transmission in Col. 4, lines 55-58, thereby making the following obvious with Joao et al:

determining the present location of the device based on a network address of the device

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine the present location based on the network address of the device with the motivation of using Internet resources to track the device's transmitted data.

As per claim 27, Joao et al discloses:

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further comprising determining the present location of the device based on a location identifier of the cellular telephone system, (Col. 1, line 24, cellular communication device).

5. Claims 3, 19, 24, 28, 29, 31, 32, 33, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao et al, (US 6,047,270), as previously cited by the examiner on 7/6/05, and furthering view of Eddy et al (US 5,812,400), as previously cited by the examiner on 1/13/06.

As per claims 3, 24, 29, 33, 34, Joao et al does not explicitly disclose the following, but does disclose a specific agreement in effect between the sales or service establishment and the bank or financial institution administering the card in Col. 7, lines 56-59, and also discloses that it is possible to specify and programmably change pin numbers or access codes for different locations in Col. 68, lines 60-65,

However, Eddy discloses a system for identifying the physical location of devices where:

when the present location of the device is not within the predetermined region, issuing a license for the device to use the funds at the present location of the device/transmitting from the remote device to a postal carrier a request for the license/wherein the communication port receives from the remote device a license to use the funds at the present location of the device from the remote device when the present location of the device indicates the present location of the device is outside the preauthorized region of

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operation/ wherein the communication port receives from the remote device a license to use the funds at the present location of the local device from the remote device when the present location of the local device indicates the present location of the local device is outside the preauthorized region of operation/ wherein the remote device requests the license from a postal carrier, (col. 10, lines 58-67, licensing requirements). Eddy et al discloses this limitation in an analogous art for the purpose of showing that meters are licensed to be operated in a particular location.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to issue a license for the device to use the funds at the present location if the location of the device is not within the predetermined region with the motivation of maintaining eligibility for operating the device.

As per claims 19, 28, 31, 32, Joao et al doesn't explicitly disclose: an apparatus for encrypting communications between the device and the remote device/further comprising an apparatus for digitally signing communications between the device and the remote device/wherein the local device further comprises an apparatus for digitally signing communications between the local device and the remote device/ wherein the local device further comprises an apparatus for encrypting communications between the local device and the remote device, but does disclose providing authorization, notification and security for devices, where transmissions include associated signatures in col. 10, lines 8-23.

However Eddy teaches that identifying the dispense postage and location identifier which indicates the amount while being verified by the postal authority to

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authenticate the authenticity of the transaction in column 11, lines 19-45. In addition, while Eddy doesn't explicitly mention digitally signing. Digitally signing relates to verification and verification is met when the postal authority examines the transaction.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include a device that is capable of digitally signing said communication for the reasons of distributing funds or assessing funds by via of postal authority authorization to make the system more efficient for operation.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 3, 5, 9, 10, 12-16, 19, 20, and 24-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

•Patent Application Information Retrieval (PAIR) system, Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A handwritten signature in black ink, appearing to read "A. R. B.", with a stylized flourish at the end.

A. R. B.
September 4, 2007